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09/497,071	02/02/2000	Linda I, Hoffberg-Borghesani	LIH-14	7065
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			EXAMINER SALCE, JASON P	
			ART UNIT 2623	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/497,071

**Applicant(s)**

HOFFBERG-BORGHESANI ET AL.

**Examiner**

Jason P. Salce

**Art Unit**

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 155-193 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 155-193 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 4/19/2007 have been fully considered but they are not persuasive.

In regards to claim 155, Applicant has amended the claim to state, "automatically performing a search of said available media for a correspondence to data representing content characteristics of the previously selected media, wherein said data representing content characteristic are not received as an input from a human user". The examiner has found support for the additional limitations at Column 65, Line 8 through Column 66, Line 57. After further review of the amendment to the claim, the examiner notes that the claim limitations (given the broadest reasonable interpretation) are still met by the teachings of Vogel (see rejection below).

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 177 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended claim 177 to state, "between data representing content characteristics a member of the set of available media programs and the data representing content", which has rendered the claim indefinite. The examiner cannot

Art Unit: 2623

assume what Applicant has intended to claim, however, in the view of expediting the prosecution of the case, the examiner will assume that the Applicant meant to place a comma between "characteristics" and "a member", which is supported by Vogel, but also is not supported by the specification (see 112 1<sup>st</sup> Paragraph rejection below).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 166-168, 177, 187 and 190-193 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner has reviewed the entire specification in regards to claims 166-168, 177, 187 and 190-193 including Column 65, Line 8 through Column 71, Line 50 and Figure 24 of the specification, which the claimed invention is specifically drawn to and no support can be found for the claims.

#### **DETAILED ACTION**

##### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2623

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 155-156 and 160-161 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Vogel (U.S. Patent No. 5,253,066).

Referring to claim 155, Vogel discloses storing data describing available media (see Column 3, Lines 49-55 for receiving periodic program schedule data which contains future and current program data and Column 3, Lines 67-68) and storing data representing previously selected media (see Column 3, Lines 59-66 for receiving real-time data that identifies programs currently being broadcast, wherein the real-time data includes different characteristics and further note that this data is transmitted after a channel change, therefore representing characteristic of media **previously selected by a user**).

Vogel also discloses automatically performing a search of said available media for a correspondence to data representing content characteristics of the previously selected media (see Column 5, Lines 13-20 for performing a search by the user initiating display of the program menu which displays the time of broadcast, title and censorship classification, all of which are part of the real time data (see Column 3, Lines 59-66), therefore initiation of the program menu clearly allows a user to perform a search of said available media for a correspondence to data representing said characteristics of media previously selected by the user), wherein said data

Art Unit: 2623

representing content characteristics are not received as an input from a human user

(again note, that the content characteristics are representative of the real-time data received after selection of the media (video program), therefore, since the real-time data (classification data) is not input by the user, clearly the content characteristics are not received as a input from a human user). **The examiner further notes that because the search is performed by the electronic system in the form of an electronic program guide, that the electronic system running the electronic program guide is processing the user input and performing functions of the electronic program guide automatically, therefore the search is being performed by the electronic system automatically, as opposed to a user manually selecting channels in sequential order.**

Vogel also discloses automatically issuing a notification of available media having characteristics corresponding to, but not identical to (see Figure 4 for not only displaying the previously selected media and available media (recorded programs) corresponding to, but not identical to (different classifications, times and channels)) previously selected media (see again Column 5, Lines 13-20 and Figure 3 for notifying the user (by displaying the program menu) where the notification contains a classification for each program). **The examiner further notes that because the notification is performed by the electronic system in the form of an electronic program guide, that the electronic system running the electronic program guide is processing the user input and performing functions of the electronic program**

**guide automatically, therefore the notification is being performed by the electronic system automatically.**

Vogel also discloses that said media comprises a media program (see Column 3, Lines 37-39 for the media comprising television programs).

Referring to claim 156, Vogel discloses that said media comprises television programs (see Figure 3 for the EPG containing television programs) and said data describing available media comprises a channel guide list (see Figure 3 for the EPG providing a channel guide list of television programs) comprising content characteristics (see again Figure 3 for the programs including channel, time and classification characteristics of the content presented).

Referring to claim 160, Vogel discloses that the data representing said characteristics of previously selected media comprises media theme information (see Column 4, Lines 40-50 for classification data C, G, A and R, which is theme information).

Referring to claim 161, Vogel discloses displaying a list of available programs (see Figure 3), and receiving an input for recording a selected one of the available programs (see Column 5, Lines 24-26).

Art Unit: 2623

Referring to claim 162, Vogel discloses a controller component configured to control delivery of a media program (see remote control 112 in Figure 1).

Vogel also discloses a processor component (see microprocessor 104 in Figure 1) configured to automatically determine a correspondence between data representing content characteristics of media within a set of available media programs with data representing content characteristics of previously presented delivered media (see Figure 3 and Column 5, Lines 13-20 for displaying an electronic program guide with programs that only correspond to the selected classifications in Figure 4), wherein said data representing content characteristics are not received as input from a human user (see the rejection of claim 155 and further note that the classification codes are received with incoming real-time data are therefore not input by a human user), and producing a signal dependent on a degree of said correspondence (see Column 4, Lines 40-68 for providing a recording or alert based on the classification (degree) of the programs in the real-time and periodic program guide data received (further note Column 6, Lines 22-66 for a more detailed example of the recording process)). **The examiner further notes that because the electronic system processes and displays the electronic program guide information by the use of a microprocessor 104, that the electronic system is performing these functions automatically.**

Referring to claim 163, Vogel discloses that said signal controls a recording of a media program (see again Column 4, Lines 4-68 for controlling the recording of a program based on the classification information).

Referring to claim 164, Vogel discloses that said signal produces a list of choices for a user through a human user interface (see Figure 4 for selecting specific classifications by the user and Figure 3 for displaying the classifications along with the corresponding user as a list of choices).

Referring to claim 165, Vogel discloses a user interaction with said system serves as an input to an adaptive algorithm of said processor for determining said correspondence (see Column 4, Lines 40-67 and Figure 4 for selecting specific classification settings and using these setting to determine the correspondence between periodic data and real-time data and perform a an event, such as alarming the user that program is available for viewing (further note Column 6, Lines 22-66)).

Referring to claim 174, Vogel discloses receiving media programming information as the data representing characteristics of media (see Column 3, Lines 59-66).

Referring to claim 175, Vogel discloses automatically generating data representing characteristics of media (see Column 3, Lines 37-45 and 59-66 for the headend generating/transmitting the data representing characteristics of media).

Referring to claim 176, Vogel discloses that the data representing characteristics comprises a description of media (see Column 3, Lines 59-62).

Referring to claim 177, see the rejection of claims 155, 162 and 168 and the 112<sup>nd</sup> rejection (see above).

Referring to claim 178, Vogel discloses that the identification of at least one member of the set of available media programs having characteristics corresponding to characteristics of previously selected media by that user is presented as a selectable object in a graphic user interface (see Figure 3).

Referring to claim 179, Vogel discloses storing data representing at least one content parameter relating prior selection by a respective user (see the rejection of claim 155 for real-time data (received after a program selection by a user) includes a content parameter in the form of a classification code), the at least one parameter not being input by the respective user (the examiner notes that the real-time data is received by the television receiver and not input by the respective user).

Vogel also discloses determining a set of available media programs (see Figure 3 for the system determining a set of programs to display on an electronic program guide), each member of the set having at least one associated content parameter (see Figure 3 for the programs in the program guide containing content parameters (classification codes)).

Vogel also discloses automatically determining a degree of correspondence of prior selections by the respective user and members of the set of available media

Art Unit: 2623

programs (see Column 4, Lines 55-67 for determining if a prior program was selected for recording, viewing or alerting and performing a subsequent action if a determination is made (which clearly represents a degree of correspondence)) based on at least the content parameters relating to prior selections by the respective user and the associated content parameters of members of the set of available media programs (see again Column 4, Lines 55-67 and note that if a user sets an alert to view a future program, then at the time the viewer receives the alert, the system compares the currently broadcasted program content parameter to the previously selected program content parameters, therefore if a match is found an alert is issued to the user (the examiner further notes that the same applies to the record and viewing functions)).

Vogel also discloses outputting a reference to at least one member of the set of available media programs based on at least the automatically determined degree of correspondence (see again Column 4, Lines 55-67 for outputting a reference in the form of recording, viewing or alerting).

Referring to claims 180-181, see the rejection of claim 178.

Referring to claim 182, see the rejection of claim 179.

Referring to claim 183, see the rejection of claims 155, 162 and 179.

Referring to claims 184-185, see the rejection of claim 156.

Referring to claim 186, Vogel discloses that the plurality of characteristics of the available media are derived from an EPG (see Column 3, Lines 37-68).

Referring to claim 187, Vogel discloses that said output comprises a displayed list of hypertext entries representing available media, further comprising receiving a selection of one of the hypertext entries (see Column 5, Lines 51-59 for each of the program listings having an option to select the "?" key with allows the program listing to become a hypertext entry that references an additional page of information about the particular television program selected from the guide page of Figure 3).

Referring to claims 188-189, see the rejection of claims 160-161, respectively.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 157-159 and 166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogel (U.S. Patent No. 5,253,066) in view of Young (U.S. Patent No. 4,706,121).

Referring to claim 157, Vogel discloses all of the limitations in claim 155, as well as that the notifying step includes the step of producing a display including a list of the available media (see Figures 3-4), and although Vogel teaches classification information corresponding to each program, Vogel is silent for the list meeting a predetermined

correspondence criteria on a display screen for viewing by the user (i.e. does not teach using the classification information to organize the program guide).

Young also discloses classification information in the form of theme data (see Column 12, Line 45 through Column 13, Line 31) and that a program guide can be displayed that only corresponds to the themes selected (see Column 12, Lines 13-14).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the program guide listings of Vogel, using the theme mode, as taught by Young, so that programs of special interest are not missed through forgetfulness and eliminating most of the program listings that are of no value to the viewer (see Column 5, Lines 20-32 of Young).

Claim 158 corresponds to claim 157, where Young discloses altering the produced display in dependence on at least input received from a data entry device (see Figures 3-5 and Column 10, Lines 6-8).

Claim 159 corresponds to claim 158, where Vogel discloses the step of selecting one of the available media items displayed on the list of available media (see Column 5, Lines 24-26 for selecting a program for recording).

Referring to claim 166, Vogel discloses all of the limitations in claim 155, but fails to teach that at least one memory stores information regarding at least two humans, wherein said signal is dependent on a defined set of humans.

Art Unit: 2623

Young teaches that at least one memory stores information regarding at least two humans, wherein said signal is dependent on a defined set of humans (see Column see Column 10, Line 65 through Column 11, Line 3 for assigning different setting for up to 4 users).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the program guide listings of Vogel, using the multiple user modes, as taught by Young, so that programs of special interest are not missed through forgetfulness and eliminating most of the program listings that are of no value to the viewer (see Column 5, Lines 20-32 of Young).

6. Claims 167 and 190-191 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogel (U.S. Patent No. 5,253,066) in view of Campbell et al. (U.S. Patent No. 4,536,791).

Referring to claim 167, Vogel discloses all of the limitations in claim 162, but fails to teach that the presentation of media is restricted in dependence on a financial transaction.

Campbell discloses that a pay-per-view system for selecting media programs requires additional billing and upon approval by the user's key entry, which allows a user to be billed a pay per view program is allowed to select the program (see Column 17, Lines 53-64).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the program selection system, as taught by Vogel,

Art Unit: 2623

using the pay per view approval system, as taught by Campbell, for the purpose of allowing the system operator to control subscription television services on a per channel, per service tier and per event basis (see Column 3, Lines 2-4 of Campbell).

Referring to claims 190-191, see the rejection of claim 167.

7. Claims 168-173 and 192-193 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogel (U.S. Patent No. 5,253,066) in view of Wachob (U.S. Patent No. 5,155,591).

Referring to claim 168, Vogel discloses a user interface for receiving a selection of a media item (see Figure 3 and Column 5, Lines 13-38) and for delivering a response to the selection (see Column 5, Lines 24-29 for recording a program in response to the selection). **The examiner further notes that because the search is performed by the electronic system in the form of an electronic program guide, that the electronic system running the electronic program guide is processing the user input and performing functions of the electronic program guide automatically, therefore the search is being performed by the electronic system automatically, as opposed to a user manually selecting channels in sequential order.**

Vogel also discloses a processor for automatically searching media items available for selection (see again Figure 3) and for presenting a recommendation of at least one available media item, based on a degree of correspondence of said selection and content characteristics of available media items input independently of a human

Art Unit: 2623

user (see Column 4, Lines 40-68 for providing a recording or alert based on the classification (degree) of the programs in the real-time and periodic program guide data received (further note Column 6, Lines 22-66 for a more detailed example of the recording process)).

Vogel fails to disclose an accounting database for recording commercial transaction data relating to selections.

Wachob discloses an accounting database for recording commercial transaction data relating to selections made by the user (see Column 10, Lines 27-35).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the television delivery system, as taught by Vogel, using the accounting database, as taught by Wachob, for the purpose of providing accurate commercial tracking and advertiser billing (see Column 10, Lines 27-28 of Wachob).

Claim 169 corresponds to claim 168, where Vogel discloses that said media items comprise television programs and said stored characteristics comprise a channel guide list (see the rejection of claim 156), and television program-descriptive text accompanies said channel guide list (see Column 5, Lines 51-57 for using the "?" key to provide a text description of a program in the channel guide list).

Claim 170 corresponds to claim 168, where Vogel discloses that said recommendation presented by said processor produces a display including a list of the

Art Unit: 2623

available media meeting a predetermined correspondence criteria on a display screen for viewing by the user (see the rejection of claim 157).

Claim 171 corresponds to claim 168, where Vogel discloses that said characteristics comprise an identification of a program type (see Column 5, Lines 40-50 for the characteristics being a classification field which can represent one of many different program types).

Claim 172 corresponds to claim 168, where Vogel discloses that said processor controls a recording of said media item (see Column 4, Lines 55-65 and Column 6, Lines 22-66).

Claim 173 corresponds to claim 168, where Wachob discloses that said database stores a history of selections made by a plurality of users (see again Column 10, Lines 27-35).

Referring to claim 192, Vogel discloses all of the limitations in claim 183, but fails to teach delivering an advertisement to the user in dependence on characteristics of media previously selected by the user.

Wachob discloses delivering an advertisement to the user in dependence on characteristics of media previously selected by the user (see Figure 4 and Column 7, Line 13 through Column 8, Line 66).

Art Unit: 2623

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the television delivery system, as taught by Vogel, using the targeted commercial advertisement system, as taught by Wachob, for the purpose of more efficiently utilizing advertising budgets (see Column 1, Lines 29-30 of Wachob).

Claim 193 corresponds to claim 192, where Wachob further discloses accounting for delivery of an advertisement to the user (see Column 10, Lines 27-35).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2623

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce  
Primary Examiner  
Art Unit 2623

July 6, 2007

JASON SALCE  
PRIMARY PATENT EXAMINER

